

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Danny C. Bowman, et al.

Serial No.: 09/737,185

Filed: December 14, 2000

Confirmation No.: 9139

Examiner: Yelena G. Gakh

Art Unit: 1797

For: **PAPERLESS CHAIN OF CUSTODY EVIDENCE FOR LAB SAMPLES**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

PETITION TO HOLD BRIEF IN COMPLIANCE

Applicant respectfully requests that the Appeal Brief filed March 27, 2008 (hereinafter referred to as "the Brief"), found to be in compliance with 37 CFR 41.37 and that the notification of Non-Compliant Appeal Brief mailed May 14, 2008 be rescinded. The Notification of Non-Compliant Appeal Brief (hereinafter referred to as "the Notification") raises two points allegedly pertaining to 37 CFR 41.37(c)(1)(v). That section of the rules requires a summary of the claimed subject matter, including a concise explanation of the subject matter defined in each of the independent claims involved in the Appeal, which must refer to the specification by page and line number, and to the drawing, if any by reference characters. The summary provided in the Brief clearly meets the requirements of the rule; it is the examiner's requirement that is not in compliance with the rules.

The first paragraph of the continuation sheet of the Notification asserts "The summary refers to step 10, Figure 4 and Figure 1 in describing the limitations of claim 1. Neither Figure 1, nor figure 4 demonstrate location of the vessels at a vessel distribution facility and transporting vessels from vessel distribution facility. The same is true for other independent claims (9, 18, 19, etc.) The Summary does not map the limitation for collecting and transporting vessels at the vessel distribution facility in the specification." Applicant asserts that those of ordinary skill in the art understand that the claimed language is enabled and described by the cited passages and figures, taking into account the understanding of the context of the disclosure by one of ordinary skill in the art. The examiner's position as set forth in the Notification appears to be an attempt

to assert a rejection under 35 USC § 112. It is now the Board's job to determine if 35 USC § 112 has been complied with, not the examiner's. The examiner has asserted her rejection under section 112 in the Office Action of applicant is appealing, and it is review of her rejection by the Board that applicant seeks. Use of the Notification to force some sort of amendment or face abandonment of the application before the Board can review the case violates applicant's RIGHT to appeal.

The second paragraph of the continuation sheet in the Notification objects to the first five pages of the summary as "not related to the concise explanation defined in the independent claims, while the rest of the summary not every detail recited in the independent claims as mapped in the specification." The summary starts on page 2 of the Brief, and the text on page 2 gives context for the interpretation of the claims. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004), MPEP 2111. For the examiner to require deletion of the text on page 2 would limit the Board to only claim language, devoid of the understanding of one or ordinary skill in the art or the specification and prevent proper claim interpretation by the Board.

Page 3 and the first two lines on page 4 of the Brief provide a concise explanation of claim 1. The two full paragraphs on page 4 provide a concise explanation of the subject matter of claim 18. Claim 18 is given a concise explanation at the bottom of page 4 through most of page 5. Claims 19 and 42 are summarized on page 5. That summary uses language that has been "mapped" in the earlier independent claims.

Additional summaries of the claims and references to the specification by page and line number appear beginning on page 7. This is done for claims 1, 8, 9, 17, 18, 19, 38, 43, 44 on pages 7-13.

Furthermore, the Board, itself, has already looked at the substance of the Brief the examiner is now complaining of and not made a similar complaint. On November 13, 2007, the Board issued an Order Returning an Undocketed Appeal to the Examiner. In that paper, the Board said that applicant's summary of the subject matter was insufficient in its addressing of

independent claims 9 and 18 (not the other claims). The deficiencies as to claims 9 and 18 have been corrected by applicant in the Brief if not on pages 4-5, then at least on pages 8-10.

The examiner's Notification of Non-Compliant Appeal Brief is simply an effort to avoid having her work reviewed by the Board of Appeals, and should be stricken. The case is now ready for jurisdiction by the Board and the case should be transferred to the Board for review. The examiner has already filed plenty of examiner's answers and supplemental examiner's answers, even having them stricken by the Board. It is time for her to step out of the way and let the Board decide.

Respectfully submitted,



Howard A. MacCord, Jr.
Registration No. 28,639
MacCord Mason PLLC
P.O. Box 2974
Greensboro, NC 27402

Date: May 19, 2008
File No.: 2552-011